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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

190252-1920

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on August 21, 2000

Signature Lindsey Corbin

Typed or printed name Lindsey Corbin

Application Number

09/740,375

Filed

December 19, 2000

First Named Inventor

Zellner, et al.

Art Unit

3622

Examiner

Duran, Arthur D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 47,283
Registration number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Zellner, et al.

Serial No.: **09/740,375**

Filed: **December 19, 2000**

For: **Identity Blocking Service from a Web Advertiser**

Confirmation No.: **4937**

Group Art Unit: **3622**

Examiner: **Duran, Arthur D.**

Docket No. **190252-1920**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The final Office Action mailed May 19, 2006 has been carefully considered. Please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

REMARKS

Rejections under 35 U.S.C. §103 are Improper

Claims 21 and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* (U.S. Patent Publication No. 2002/0102993). Claims 22-25 and 27-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* in view of *Goldhaber* (U.S. Patent No. 5,794,210). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). A review of the *Hendrey* and *Goldhaber* references, however, reveal that the references and the proposed combination do not teach each and every limitation of Applicant's claims as is required by 35 U.S.C. §103.

a. Claims 21 and 26

As provided in independent claim 21, Applicants claim:

A method of sending an advertisement to a user operating a wireless communication device, comprising:

sending first information about a location of the user to a content provider that provides web content to the wireless communication device;

sending an indication to the content provider when the location is continuously changing;

searching a first database containing a plurality of location-specific advertisements;

selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and

sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing.

(Emphasis added).

The final Office Action states that "Hendrey does not explicitly disclose that the advertisements are sent when the user's location is stable. However, Hendrey discloses tracking the user being both moving and stable (see above citations), that particular indications

concerning advertisements can be made when the user's location is stable at certain areas ([47]), that the various features and embodiments of the Hendrey disclosure can be utilized for targeting advertisements ([53]), that there are many variations and factors for targeting a user [(32, 33, 34, 58)] and that there are many possible variations of the Hendrey disclosure ([66])." Pages 3-4. The Office Action therefore alleges that it would be obvious for the information in Hendrey's Fig. 1, including whether the user is moving or the location is stable, to be utilized for targeting the user. *See* page 4. Applicants respectfully disagree.

For example, with respect to Fig. 1 of *Hendrey*, it shows an MU 110, a store 100, a telecommunication system infrastructure 120 with processor 107, prospect tracking manager 130, location sensitive advertising content generator 131, location tracking subsystem 132, and advertising effectiveness database 133. This by itself does not suggest or teach tracking a location of a user, determining whether the location is constantly changing, and sending advertisements which are desired to be sent when the location is determined to be stabled and not constantly changing. Regarding paragraphs 0053 and 0066 cited above, they do not disclose tracking when the user's location is constantly changing or stable. Regarding paragraph 0058 cited above, it discusses identifying distances and "whether a particular user is close enough to a predetermined location to be likely to respond to an advertisement." As such, this passage does not disclose tracking when the user's location is constantly changing or stable. Regarding paragraphs 0032-0034 cited above, these passages discuss the distance within which an MU is within a store before an advertisement is sent. Regarding paragraph 0047 and gauging responsive to advertising content (*see* paras. 0045-0046), paragraph 0047 states:

A first technique is to monitor the general location of MU 110 over a period of time to see if traveling of the prospect ceased in the general vicinity of store 100 even if insufficient positioning accuracy is available to determine whether the prospect visited the store or merely stopped nearby it. This provides suggestive evidence that the advertisement caused the user of MU 110 to stop and shop at store 100 even if no purchase is recorded or there is insufficient information to tie a purchase to the user of MU 110. Preferably, such cessation of motion is screened for false alarms if the area in which such cessation took place was historically common, for example indicating the location of the user's work or home location.

This fails to teach or contemplate suggesting "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to

the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. Further note that paragraph 0053 referenced previously states, "Another variant of the embodiments discussed above is a system that creates and sends advertising content, but does not track the effectiveness of advertising (i.e., incorporates the elements of FIG. 1 except for effectiveness database 133, and has an operation corresponding only to steps 201, 202, and 210 in FIG. 2)." Thus, a system described in paragraph 0053 is a system that sends advertising content in a manner described with respect to FIG. 1, but does not include the tracking steps with respect to tracking effectiveness of advertising, such as that described with respect to paragraph 0047.

Applicants submit that a *prima facie* case of obviousness has not been established, since a reference has not been cited that discloses at least "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. The Office Action states that it would be obvious to modify the *Hendrey* reference to include a claimed limitation without providing any support to show that the claimed limitation has been previously disclosed or is known. It is noted "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *see also* MPEP 2143.03. Further to establish a *prima facie* case of obviousness, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

As such, *Hendrey* fails to establish a *prima facie* case of obviousness, and the rejection of claim 21 and claim 26 which depends therefrom should be withdrawn, for at least this reason.

b. Claims 22-25 and 27-30


Because independent claim 21 is allowable over the cited art of record, dependent claims 22-25 and 27-30 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-25 and 27-30 contain all the steps and features of independent claim 21 and the cited art of *Goldhaber* fails to remedy the deficiencies of the

Hendrey reference. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of claims 22-25 and 27-30, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record.

CONCLUSION

As is apparent from the foregoing, the cited references are woefully deficient in disclosing Applicants' claims. Therefore, application of the cited references against Applicant's claims under 35 U.S.C. §103 rises to the level of clear legal and/or factual error. Applicants therefore request that the rejections of the final Office Action be withdrawn and a new, non-final Office Action, or Notice of Allowance, be issued.

Respectfully submitted,



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